

Remarks/Arguments

Upon entry of this paper, the claims have the following status: claims 26–30 are currently being examined, claim 26 is amended, claims 18–25 and 31–55 are withdrawn, and claims 1–17 are cancelled.

Restriction/Election

Applicant thanks the Examiner for the detailed discussion in the April '09 Action. Applicant repeats for the record, however, the contention that the claims define the scope of the invention, and a designation of a particular species associated with one or more drawings being associated with one or more particular claims, although done in good faith, should not be considered exclusive.

Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 26 and 28–30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,337,733 (filed Sep. 11, 1990)(“Bauerfeind et al.”). April '09 Action, at 6–7. Applicant has amended independent claim 26 to particularly point out and distinctly claim inventive subject matter. Applicant believes that claim 26, as amended, is patentable over Bauerfeind et al.

In Bauerfeind et al.’s Fig. 2 and associated text, “support elements 32” appear to be part of “inner wall 16”, and “support elements 36” appear to be part of “outer wall 18”. See e.g., col. 5, lines 47–62. With reference to Figs. 4–6, and especially Fig. 5 and associated text, Bauerfeind et al. appear to disclose an embodiment in which support elements 32 and 36 are described as “ring- or sleeve-like”, and each have a “spherical outer face” and “corrugations”. See col. 6, line

58—col. 7, line 16. It appears that the support elements disclosed in Bauerfeind et al. prevent the inner wall and outer wall from sliding lengthwise with reference to one another. Instead, Bauerfeind et al. appear to disclose that a “colonoscope 50” may slide lengthwise inside inner wall 16. See e.g., Figs. 3a–3f; col. 5, line 63–col. 6, line 57. Bauerfeind et al. do not appear to disclose or suggest that the inner and outer walls may slide lengthwise with reference to one another.

In contrast to Bauerfeind et al.’s disclosure, amended independent claim 26 recites that the “plurality of components positioned between the inner and outer elements” are “distinct from the inner and outer elements”. Further, claim 26 recites that the “inner and outer elements” may slide “lengthwise relative to one another”, and that “in a second state the components do not significantly interfere with” such sliding. Consequently, Applicant believes that independent claim 26 is patentable over Bauerfeind et al. Likewise, dependent claims 28–30 are patentable over Bauerfeind et al.

With specific reference to claim 28, the Examiner appears to argue that Bauerfeind et al. disclose “balloons” and cites support elements 32 and 36 in support. But these support elements do not appear to be disclosed as or suggested to be “balloons”, but instead appear to be solid pieces.

With specific reference to claim 29, the Examiner appears to argue that Bauerfeind et al.’s support elements are disclosed as “energized and expanded radially”. But although Bauerfeind et al. appear to disclose that support elements 32 may move radially outwards, they do not appear to disclose or suggest that the support elements themselves are either “energized” or “expanded radially”. Instead, inner wall 16 expands radially and carries support elements 32.

With specific reference to claim 30, as discussed above for claim 29, although Bauerfeind et al. appear to disclose that support elements 32 are moved radially inward as inner wall 16 contracts, they do not appear to disclose or suggest that the support elements themselves are “energized” or “contracted radially”.

Rejections Under 35 U.S.C. § 103

The Examiner has rejected dependent claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Bauerfeind et al. April ‘09 Action, at 7–8. Applicant respectfully disagrees because Bauerfeind et al. do not appear to disclose or suggest each and every element recited in the rejected claim.

As discussed above, Bauerfeind et al. do not appear to disclose or suggest several elements recited in independent claim 26. Applicant agrees with the Examiner’s assertion that Bauerfeind et al. do not expressly disclose an “electroactive polymer”. April ‘09 Action, at 8. But Applicant disagrees with the Examiner’s assertion that Bauerfeind et al. disclose “expanding components comprising gas/fluid expandable components”, because Bauerfeind et al.’s support elements themselves are not expandable. Therefore, the use of an electroactive polymer as recited in claim 27 is not a mere “design choice” as the Examiner appears to argue, see *Id.*, because Applicant’s claimed “components” act in a way different from Bauerfeind et al.’s support elements. Consequently, dependent claim 27 is patentable over Bauerfeind et al.

Objection to Specification

The Examiner objected to paragraph 0067 and requested correction. April ‘09 Action, at 6. Applicant believes that the requested correction to paragraph 0067 was made in a paper filed

on 11 December 2007, and that this amendment was entered and acknowledged in the Office Action mailed 29 October 2008. As the Examiner has requested, the paper filed on 11 December 2007 also included several other amendments that correct formal errors in the specification.


Conclusion

Applicant requests the amendments in this paper be entered, and that the Examiner reconsider this application. Please contact the undersigned attorney at 408-523-2460 if there are any questions or if a telephone conversation would quickly resolve a matter.

Applicant includes with this paper a petition for three-month extension of time and associated fee authorization, allowing until 7 October 2009 to respond.

Applicant believes that there are no additional fees associated with this paper. If such fees are due for this paper, however, any required fees or overpayments are authorized to be deducted or credited to Deposit Account No. 503404.

Respectfully Submitted,



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